

### **REMARKS/ARGUMENTS**

Claims 1-16 are pending in the application. New Claim 17 has been added in this amendment. Reconsideration and reexamination of the application are hereby respectfully requested.

#### **In the Specification:**

During preparation of this Amendment, it was noted that the Specification and Drawings use reference number 15 to refer to both the motor and the "rearward edge of the upper portion of the motor housing." Therefore, Paragraphs [0026] and [0027] are amended herein to use reference number (26a) to refer to the rearward "rim" of the upper portion of motor housing (3).

#### **In the Claims:**

Claims 1-16 stand rejected under 35 U.S.C. 112, second paragraph, as indefinite. The examiner finds the claims to be generally narrative and failing to comply with current US practice. Claims 1-16 are amended herein to bring them into compliance with US practice and requirements.

Claims 1, 2, 3, 5, 8, and 15 stand rejected under 35 U.S.C. §102(b) as anticipated by US 4,588,910 to Bausch. Dependent claims 6, 7, 13, 14 and 16 stand rejected under 35 U.S.C. §103 as unpatentable over Bausch '910 in combination with other references. The Applicants respectfully traverse these rejections.

The Examiner claims to find all the limitations of independent claim 1 in Bausch '910. Independent claim 1 (both in its original form and as amended) require that the forward/reverse switch (14) (now second manually operable switch member) is "located remotely from the switch unit (6) on a portion of the tool housing which can be seen by a user of the tool during normal operation of the tool" (emphasis added). In contrast, in the Background of the Invention section of the subject application, the applicants describe the prior art as teaching the location of the forward/reverse lever

“generally . . . in the region of the trigger switch of the tool, and so is difficult for the user to see while the tool is being operated.” Para. [0004]. This prior art arrangement is depicted in Fig. 1 of the subject application and further described in paragraph [0022]. As required by independent claim 1, the preferred embodiment of the subject application, however, locates the reversing switch 14 on the top surface of the tool housing, where it would be easily “seen by a user of the tool during normal operation of the tool.”

As to the location of the forward/reversing switch, Bausch ‘910 clearly teaches the prior art as described and depicted in the subject application. Slide 9 is the manually operable forward/reverse switch of Bausch ‘910. Bausch ‘910 col. 4, lines 11-13. Slide 9 and the associated switching components are repeatedly depicted in close physical proximity to the trigger 2 and in a region that would be obscured from the user by the bulk of the motor housing above and/or by the user’s grip on the tool around the handle when in normal use. *See* Bausch ‘910 Figures 1, 4, and 5; *compare* Fig 1. prior art of the subject application. The Applicants must strenuously disagree with the Examiner’s description (in his remarks regarding claims 2 and 3) that Bausch discloses slide 9 “on a portion of the tool which can be seen by the user and on an upwardly portion of the tool.” As shown in Bausch ‘910, slide 9 is neither readily visible “during normal operation of the tool” nor is it located on an upwardly facing portion of the tool. Rather, it is located precisely as described in the prior art and not as required by independent claim 1.

The Applicant’s respectfully submit that they have traversed the Examiner’s §102(b) rejection of independent claim 1 as anticipated by Bausch ‘910. Therefore, it is not necessary to independently address the §102(b) and §103 rejections of dependent claims 2-16.

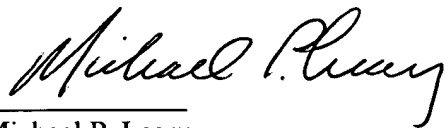
New independent claim 17 is submitted for consideration. In view of the traversal of the pending rejections, Applicant’s believe that new claim 17 will require no new searching or analysis

**In the Drawings:**

The Drawings stand objected to as informal and do not conform with current US practice. Additionally, Figure 1 is not properly labeled as "Prior Art."

Replacement drawing conforming to US practice are submitted and Figure 1 has been labeled as prior art. Furthermore, during preparation of this Amendment, it was noted that the Specification and Drawings use reference number (15) to refer to both the motor and the "rearward edge of the upper portion of the motor housing." Therefore, Figure 4 is amended to use reference number (26a) to refer to the rearward "rim" of the upper portion of motor housing (3). The addition of reference number (14) and deletion of reference number (28) from Fig. 2 is purely editorial.

Respectfully submitted



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**Amendments to the Drawings:**

Please cancel/delete the original three sheets which include original Figures 1, 2, 3A, 3B, and 4.

The attached three replacement sheets replace all the original sheets including Figures 1, 2, 3A, 3B, and 4. In these amended Figures:

- the drawing quality has been improved to conform to US practice;
- Fig. 1 has been labeled as "Prior Art";
- in Fig. 2, reference number 28 has been deleted;
- in Fig. 2, reference number 14 has been added; and
- in Fig. 4, reference number 26a has been substituted for reference number 15.

Attachment: 3 Replacement Sheets of Drawings  
2 Annotated Sheet Showing Changes From The Original.

PRIOR ART  
 FIG. 1

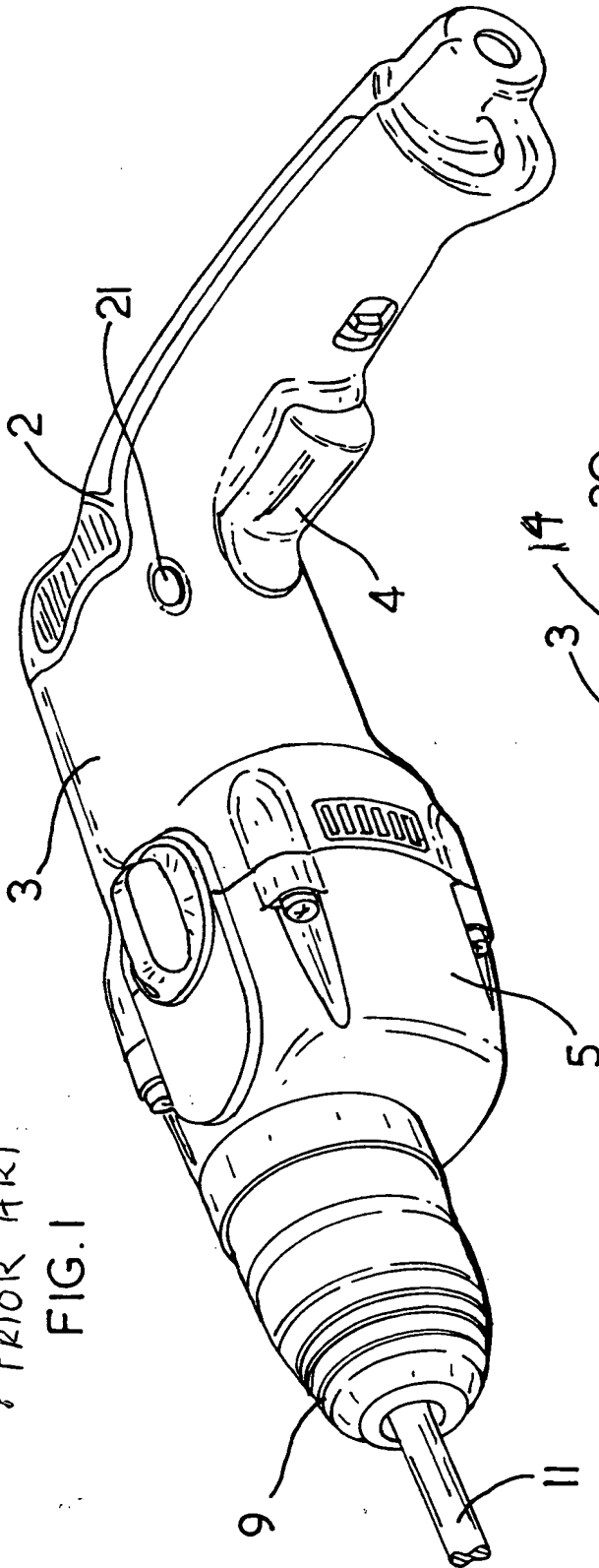
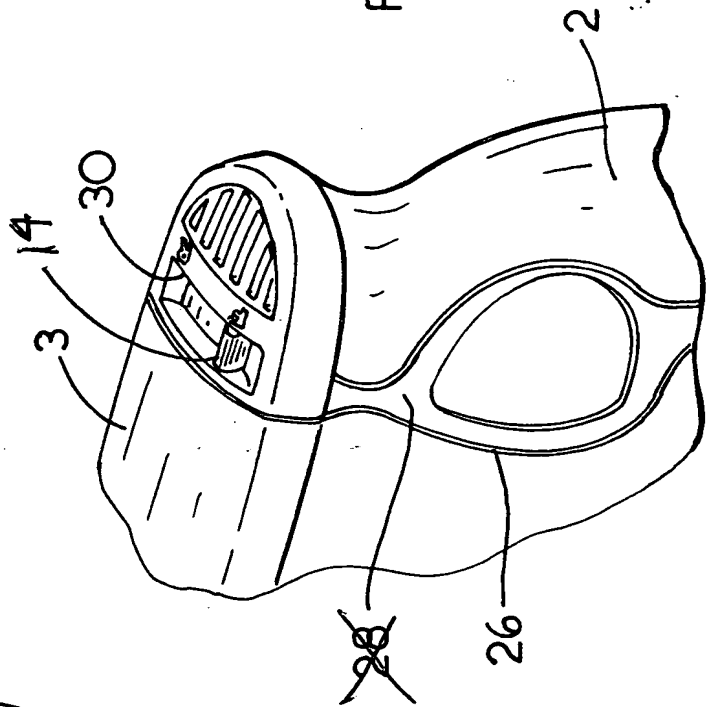


FIG. 2



**Serial No.:** 10/712,327      **Title:**  
**Elec. Motor Driven Hand Held Tool**  
**Inventor:** Daniel Craven, et al.  
**Docket No.:** P-US-PR 1091  
~~Replacement Sheet~~ 2 of 2  
*Annotated*



FIG. 4